

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

SEPT 18, 97

Paper No. 9  
GDH/LCB

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Volk Optical, Inc.

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Serial No. 74/628,209

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Brian J. Hundertmark of Roberts & Hundertmark for applicant.

Ari Leifman, Trademark Examining Attorney, Law Office 102  
(Myra Kurzbard, Managing Attorney)

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Before Simms, Hohein and Walters, Administrative Trademark  
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Volk Optical, Inc. has filed an application to register  
the term "SMALL PUPIL" for an "ophthalmoscopy [sic] lens."<sup>1</sup>

Registration has been finally refused under Section  
2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the  
basis that, when used in connection with applicant's goods,  
the term "SMALL PUPIL" is merely descriptive of them.

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<sup>1</sup> Ser. No. 74/628,209, filed on February 1, 1995, which alleges  
a bona fide intention to use the term.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a designation or term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic of feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a designation or term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the designation or term describes a significant attribute or idea about them. Moreover, whether a designation or term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the designation or term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers

could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365,366 (TTAB 1985).

Applicant argues that the term "SMALL PUPIL" "clearly does not specifically describe an ophthalmoscopy lens, nor does it describe a purpose or function of the goods." Such term, according to applicant, "is only suggestive of some of the characteristics of the goods on which it is used." In particular, applicant points out that:

[T]he lens on which [the term] SMALL PUPIL is to be used is a high-powered miniaturized version of a wide field lens. While the lens can be used to view a patient's eye without dilation of the pupil, a major purpose of the lens is to permit, following dilation of the pupil, extreme off-axis illumination. This virtually eliminates lens, cornea, and retinal reflections.

Thus, while admitting that the term "SMALL PUPIL" "is descriptive of one possible use of the ophthalmoscopy lens ... (to examine an eye through a small pupil)," applicant contends that such term "would not serve as a description of the goods that would be of any use to ... potential purchasers" of its product, which is "sold to ophthalmologists and medical institutions."

In addition, applicant notes that, while the excerpts of record (detailed in part below) from the Examining Attorney's "NEXIS search describe various diseases and conditions that include a small pupil as a symptom, and

various procedures that are used to look at small pupils," "[a]t no place in any of the articles does the term 'small pupil' refer to an ophthalmoscopy lens." Thus, according to applicant:

There is no conelation between a disease with a symptom of small pupils and a high-powered miniature lens that is mainly used to look at pupils after they have been dilated. The Examining Attorney's focus on articles that discuss small pupils reinforces his misinterpretation of the main use of the lens, [which is] to view pupils after dilation.

Therefore, applicant insists, "the trademark SMALL PUPIL is not 'merely descriptive' of the goods, but is only suggestive of one possible use of the goods."

The Examining Attorney, on the other hand, maintains that the term "SMALL PUPIL," as applied to ophthalmoscopy lenses, conveys information about a significant attribute of applicant's goods. Specifically, the Examining Attorney urges that such term "is merely descriptive of the types of pupils - SMALL PUPILS - which the goods are designed to examine." In this regard, the Examining Attorney relies upon excerpts from numerous articles retrieved and made of record from his search of the "NEXIS" data base.<sup>2</sup> Such articles, as applicant concedes, principally demonstrate, according to the Examining Attorney, that:

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<sup>2</sup> The search on February 26, 1996 of the "ALLNWS" file of the "NEWS" library, using the search request "SMALL PUPIL AND NOT TEACHER," disclosed 58 stores from which excerpts were taken.

SMALL PUPIL is used to name a condition in which a patient's pupil[s] are small. This smallness may recur naturally in a patient, or may be the result of illness or medication. ... [Thus,] SMALL PUPIL is [merely] descriptive because it refers to a central characteristic of the goods: it names the type of pupil which the [applicant's] goods are designed to examine.

To bolster his conclusion of mere descriptiveness, the Examining Attorney observes that "applicant does not dispute the finding that one [significant] use of its goods is the examination of small pupils" since applicant, as noted previously, has admitted that "SMALL PUPIL is descriptive of one possible use of the [applicant's] ophthalmoscopy lens ... (to examine an eye through a small pupil) ..."

Moreover, although not specifically addressed by either applicant or the Examining Attorney, it has not escaped our gaze that three of the "NEXIS" excerpts discuss ophthalmoscopy of small pupils (**emphasis added**):

Scanning laser **ophthalmoscopy** was introduced in 1980 ... Since then, it has been established as a clinical tool that requires low levels of illumination and is thus comfortable for the patient, allows imaging through **small pupils**, captures images with large depth of field, and allows imaging through less-than-perfect media. By introducing a small pinhole aperture in a plane corresponding to the focus plane, one can image optical slices of the retina ... -- American Journal of Ophthalmology, November 1995, at 642;

Indirect **ophthalmoscopy** [sic] (**small pupil**) as used for examination of the

retina. - Id., May 15, 1993, at 629;  
and

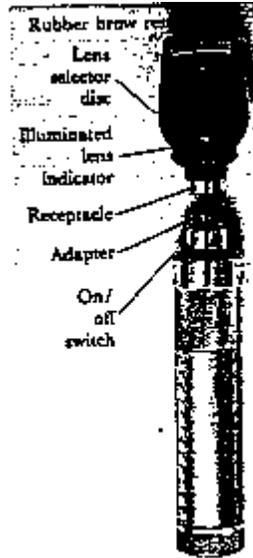
A small aperture is essential for eye examination conducted without pupil dilation (see "The pros and cons of pupil dilation"). In fact, all eye examinations should probably begin with this aperture, especially if the patient has **small pupils**. Even when the pupil is wide open, this aperture facilitates close examination of discrete areas and is particularly useful for examining the macula ... -- Patient Care, November 30, 1987, at 52 (article headlined, in part: "Is your **ophthalmoscope** a dinosaur?").

Also, by way of background, we judicially notice the following definitions<sup>3</sup> from Mosby's Medical Dictionary (4<sup>th</sup> ed. 1994):

"**ophthalmoscope**," which is defined at 1110 as "a device for examining the interior of the eye. It includes a light, a mirror with a single hole through which the examiner may look, and a dial holding several lenses of varying strengths. The lenses are selected to allow clear visualization of the structures of the eye at any depth. If the patient or the examiner ordinarily requires extensive correction of a refractive error, the examination may require that the corrective lenses normally worn be worn for the examination. (See Fig. P. 1109 [reproduced below].)";

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<sup>3</sup> It is settled that the Board may properly take judicial notice of dictionary definitions, including definitions in technical reference works. See, e.g., In re Hartop & Brandes, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962); Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).



"**ophthalmoscopy**," which is listed at 1110 as meaning an ophthalmoscope to examine the eye."; and "**pupil**," which is set forth at 1309 as connoting "a circular opening in the iris of the eye, located slightly to the nasal side of the center of the iris. The pupil lies behind the anterior chamber of the eye and the cornea and in front of the lens. Its diameter changes with contraction and relaxation of the muscular fibers of the iris as the eye responds to changes in light, emotional states, and other kinds of stimulation. The pupil is the window of the eye through which light passes to the lens and the retina."

Likewise, Stedman's Medical Dictionary (16<sup>th</sup> ed. 1995) contains the following pertinent definitions:"<sup>4</sup>

"**oph·thal·mo·scope**," which is defined at 1254 as "[a] the interior of the eyeball through the pupil. SYN funduscope .....

**direct o.**, an instrument designed to visualize the interior of the instrument relatively close to the subject's eye and the observer viewing an upright magnified image.

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<sup>4</sup> In this regard, the same dictionary at 694 lists "fundus" as signifying "[t]he bottom or lowest part of a sac or hollow organ; that part farthest removed from the opening or exit ..."

**Indirect o.**, an instrument designed to visualize the interior of the eye, with the instrument at arm's length from the subject's eye and the observer viewing an inverted image through a convex lens located between the instrument and the subject's eye.";

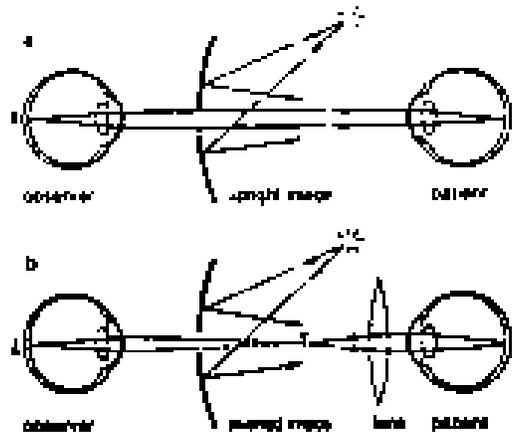
"**oph·thal·mos·co·py**," which is listed at 1254 as meaning "[e]xamination of the fundus of the eye by means of the ophthalmoscope. SYN funduscopy.

**direct o.**, o. performed with a direct ophthalmoscope.

**indirect o.**, o. performed with an indirect ophthalmoscope.

**o. with reflected light**, examination of that part of the fundus adjacent to an area illuminated by a sharply focused light."; and  
"pupil," which is set forth at 1468 as connoting "[t]he circular orifice in the center of the iris, through which the light rays enter the eye."

Such dictionary at 1254 also contains the following schematic illustration:



Upon consideration of the above evidence and arguments, it is our view that, when applied to an ophthalmoscopy lens, the term "SMALL PUPIL" immediately describes, without conjecture or speculation, a significant purpose or function

of applicant's product, namely that it is specifically for use in examining a small pupil. As applicant has admitted, such term "is descriptive of one possible use of the ophthalmoscopy lens," which is "to examine an eye through a small pupil." That such a use is a significant purpose or function of an ophthalmoscopy lens is made clear by the three "NEXIS" excerpts reproduced herein. It is simply not necessary, as the Examining Attorney has correctly pointed out, that a term describe every characteristic, feature, purpose, function, ingredient, quality or other aspect of a product in order for it to be merely descriptive. It is sufficient, instead, if the term, as here, describes one significant attribute of the product. See, e.g., In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985); In re Aid Laboratories, Inc., 223 USPQ 357, 358-59 (TTAB 1984); In re H.U.D.D.L.E., 216 USPQ 358, 359 (TTAB 1982); and In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Plainly, to ophthalmologists, eye surgeons and other medical practitioners who conduct ophthalmoscopic examinations and who would be the principal purchasers of ophthalmoscopy lenses, there is nothing in the term "SMALL PUPIL" which is ambiguous, incongruous, indefinite or too abstract, nor would any imagination, cogitation, mental processing or gathering of further information be necessary in order such persons to perceive precisely the merely

descriptive significance of such term as it relates to one purpose or function of what applicant's product does. Moreover, the fact that applicant's ophthalmoscopy lens "will mainly be used to view pupils after dilation" does not preclude a finding of mere descriptiveness. Applicant concedes that its product "can be used to view a patient's eye without dilation of the pupil." Plainly, an ophthalmoscopy lens which can be used to examine a small pupil later after dilation, thereby eliminating the need to change the lens on the ophthalmoscope, is aptly and precisely described as a small pupil ophthalmoscopy lens.

Accordingly, because the term "SMALL PUPIL" conveys forthwith a significant purpose or function of applicant's product, namely, that its ophthalmoscopy lens is particularly suitable for use in examining patients with the condition of a small pupil, such term is merely descriptive within the meaning of the statute.

**Decision:** The refusal under Section 2(e)(1) is affirmed.

R. L. Simms

R. F. Cissel

G. D. Hohein  
Administrative Trademark Judges,  
Trademark Trial and Appeal